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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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33804	7590	02/01/2005	EXAMINER	
SUPREME PATENT SERVICES POST OFFICE BOX 2339 SARATOGA, CA 95070			STULTZ, JESSICA T	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,783

Applicant(s)

HONG, SHINN-GWO

Examiner

Jessica T Stultz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-32 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-8, 10-11, 13-21, 23, 25-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Lally et al.

Regarding claims 1 and 28, Lally et al discloses a reactive tinting compound and method of preparing a reactive tinting compound for tinted contact lens (Column 1, lines 7-11 and Column 3, lines 34-57, wherein a polymeric article and a dye are reacted to form a tint for contact lenses) comprising the steps of: carrying out a reaction of a first compound with a second compound to generate a product of reactive tinting compound (Column 1, lines 7-11 and Column 3, lines 34-57, wherein the first compound is a polymeric article, either a polymeric precursor or prepolymer and the second compound is a radiation-absorbing dye are reacted to form a reactive tint for contact lenses), wherein the first compound is primarily a hydrophilic compound with pendant hydroxyl and unsaturated vinyl groups (Column 8, line 59-Column 9, line 61, wherein the prepolymer is n-vinylpyrrolidone/vinyl acetate, which is a hydrophilic compound with pendant hydroxyl and unsaturated vinyl groups and wherein the prepolymer includes 5-20% of either methacrylamide, hydroxyethyl acrylate, which are hydrophilic compounds with pendant hydroxyl and unsaturated vinyl groups), and the second compound is a radiation-absorbing and water soluble dye with substituted beta-sulphatoethylsulphone reactive group (Column 15, lines

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6-52, wherein the radiation-absorbing dyes are beta-sulphatoethylesulphone derivative, specifically Reactive Yellow 15, Reactive Blue 19 and Reactive Blue 21); and recovering the product after the reaction is complete (Column 1, lines 7-11 and Column 3, lines 34-57 and Figure 2, wherein the prepolymerization mixture is recovered and then dispensed into a lens mold).

Regarding claim 2, Lally et al further discloses that the molar ratio of the first compound to the second compound is 1/1 to 5/1 (Column 15, lines 43-65, shown in Figure 3, wherein the molar ratio of the polymer precursor and the dye is 1/1).

Regarding claim 3, Lally et al further discloses that the first compound is hydroxyl ethyl acrylate (Column 8, line 59-Column 9, line 61, wherein the prepolymer comprises hydroxyethyl acrylate).

Regarding claim 5, Lally et al further discloses that the second compound is substituted beta-sulphatoethylsulphone reactive group, specifically Reactive Yellow 15, Reactive Blue 19, or Reactive Blue 21 (Column 15, lines 6-52, wherein the radiation-absorbing dyes are beta-sulphatoethylesulphone derivative, specifically Reactive Yellow 15, Reactive Blue 19 and Reactive Blue 21).

Regarding claim 6, Lally et al further discloses the steps of preparing a mixture of a first compound, a base compound, and a polymerization inhibitor in water (Column 20, lines 31-54, Figure 2, wherein the polymer precursor functionalizer is mixed with the prepolymer, wherein the polymer precursor includes an inhibitor, water, and a base compound, specifically sodium hydroxide); mixing the second compound with the mixture of the first step (Column 20, lines 18-26, wherein the functionalization of the dye includes diluting Blue 19 in water), and initiating a

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synthesis reaction of the reactive tinting compound under heating (Column 21, lines 24-32, wherein cross linking of the dye and the prepolymer occurs due to heating).

Regarding claim 7, Lally et al further discloses that the molar ratio of the first compound to the second compound is 1/1 to 5/1 (Column 15, lines 43-65, shown in Figure 3, wherein the molar ratio of the polymer precursor and the dye is 1/1).

Regarding claim 8, Lally et al further discloses that the first compound is hydroxyl ethyl acrylate (Column 8, line 59-Column 9, line 61, wherein the prepolymer comprises hydroxyethyl acrylate).

Regarding claim 10, Lally et al further discloses that the base compound is an alkaline metal hydroxide (Column 20, lines 31-54, wherein the base compound is sodium hydroxide, i.e. and alkaline metal hydroxide).

Regarding claim 11, Lally et al further discloses that the molar ratio of the base compound to the second compound is 1/1 to 5/1 (Column 15, lines 43-65, shown in Figure 3, wherein the molar ratio of the polymer precursor and the dye is 1/1).

Regarding claim 13, it is inherent from Lally et al further discloses that the polymerization inhibitor is 0.02 to 3% of the first compound, this being reasonably based upon the addition of a minimal amount of the inhibitor (Column 20, line 28-Column 21, line 21, wherein the first compound is the purified cross linkable prepolymer which contains only 50 mg of the inhibitor).

Regarding claim 14, Lally et al further discloses that the reaction is at 50 to 100 degrees Celsius (Column 21, lines 24-32, wherein the reaction occurs between 25-60 degrees Celsius).

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Regarding claim 15, Lally et al further discloses that the reaction is for 12-24 hours (Column 20, line 9-Column 21, line 32, wherein the preparation of the cross linkable polymer takes 20 hours).

Regarding claim 16, Lally et al further discloses the steps of activating the second compound with a base compound in water (Column 20, lines 18-26, wherein the Reactive Blue 19 is mixed with a base compound, specifically sodium carbonate, and water); mixing the first compound with the resulting mixture of the previous step (Column 20, line 15-Column 21, line 32, wherein the functionalized dye is mixed with the first compound, i.e. the prepolymer); optionally mixing a polymerization inhibitor with the mixture of the previous step and initiating a synthesis reaction of the reactive tinting compound (Column 20, line 31-Column 21, line 32, Figure 2, wherein the polymer precursor functionalizer is mixed with the prepolymer, wherein the polymer precursor includes an inhibitor and wherein the dye and prepolymer are mixed to form a reactive tinting compound).

Regarding claim 17, Lally et al further discloses that the activating step is at 30 to 80 degrees Celsius (Column 15, line 41-Column 16, line 19, wherein the activation temperature is 30-50 degrees Celsius).

Regarding claim 18, Lally et al further disclose that the activating step is about 10-45 minutes, which falls within the range of 0.5 to 4 hours (Column 20, lines 18-26).

Regarding claim 19, Lally et al further discloses that the molar ratio of the first compound to the second compound is 1/1 to 5/1 (Column 15, lines 43-65, shown in Figure 3, wherein the molar ratio of the polymer precursor and the dye is 1/1).

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Regarding claim 20, Lally et al further discloses that the first compound is hydroxyl ethyl acrylate (Column 8, line 59-Column 9, line 61, wherein the prepolymer comprises hydroxyethyl acrylate).

Regarding claim 21, Lally et al further discloses that the second compound is substituted beta-sulphatoethylsulphone reactive group, specifically Reactive Yellow 15, Reactive Blue 19, or Reactive Blue 21 (Column 15, lines 6-52, wherein the radiation-absorbing dyes are beta-sulphatoethylesulphone derivative, specifically Reactive Yellow 15, Reactive Blue 19 and Reactive Blue 21).

Regarding claim 23, Lally et al further discloses that the molar ratio of the base compound to the second compound is 1/1 to 5/1 (Column 15, lines 43-65, shown in Figure 3, wherein the molar ratio of the polymer precursor and the dye is 1/1).

Regarding claim 25, it is inherent from Lally et al further discloses that the polymerization inhibitor is 0.02 to 3% of the first compound, this being reasonably based upon the addition of a minimal amount of the inhibitor (Column 20, line 28-Column 21, line 21, wherein the first compound is the purified cross linkable prepolymer which contains only 50 mg of the inhibitor).

Regarding claim 26, Lally et al further discloses that the reaction is at room temperature to 50 degrees Celsius (Column 21, lines 25-32, wherein the reaction occurs between 25 to 60 degrees Celsius).

Regarding claim 27, Lally et al further discloses that the reaction is for 12-24 hours (Column 20, line 9-Column 21, line 32, wherein the preparation of the cross linkable polymer takes 20 hours).

Regarding claim 29, Lally et al further discloses a tinted contact lens comprising a hydrophilic monomer material (Column 18, line 43-Column 20, line 14, wherein the lens is made from cross linking with co monomers, i.e. hydrophilic monomers), an inert diluent (Column 20, lines 54-63, wherein the cross linking polymer is diluted with water), an acrylic cross linker with multiple unsaturated vinyl groups (Column 17, line 64-Column 20, line 14, wherein the lens is made using an acrylic cross linker) and a reactive tinting compound prepared by the steps comprising (Column 1, lines 7-11 and Column 3, lines 34-57, wherein a polymeric article and a dye are reacted to form a tint for contact lenses and Column 21, lines 35-45, wherein a tinted contact lens is formed): carrying out a reaction of a first compound with a second compound to generate a product of reactive tinting compound (Column 1, lines 7-11 and Column 3, lines 34-57, wherein the first compound is a polymeric article, either a polymeric precursor or prepolymer and the second compound is a radiation-absorbing dye are reacted to form a reactive tint for contact lenses), wherein the first compound is primarily a hydrophilic compound with pendant hydroxyl and unsaturated vinyl groups (Column 8, line 59-Column 9, line 61, wherein the prepolymer is n-vinylpyrrolidone/vinyl acetate, which is a hydrophilic compound with pendant hydroxyl and unsaturated vinyl groups and wherein the prepolymer includes 5-20% of either methacrylamide, hydroxyethyl acrylate, which are hydrophilic compounds with pendant hydroxyl and unsaturated vinyl groups), and the second compound is a radiation-absorbing and water soluble dye with substituted beta-sulphatoethylsulphone reactive group (Column 15, lines 6-52, wherein the radiation-absorbing dyes are beta-sulphatoethylesulphone derivative, specifically Reactive Yellow 15, Reactive Blue 19 and Reactive Blue 21); and recovering the product after the reaction is complete (Column 1, lines 7-11 and Column 3, lines 34-57 and

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Figure 2, wherein the prepolymerization mixture is recovered and then dispensed into a lens mold).

Regarding claim 30, it is inherent from Lally et al that the reactive tinting compound be 0.01 to 0.25 percent based on the weight of the hydrophilic monomer material, this being reasonably based upon the small amount of dye added to the cross linked solution (Column 21, lines 24-45, wherein 1 gram of dye is added to the purified cross linked solution and therefore the resultant lens would have 0.01 to 0.25 percent of reactive tinting).

Regarding claim 31, Lally et al further discloses that the hydrophilic monomer material comprises hydroxyl ether methacrylate, methacrylic acid or n-vinyl pyrrolidone (Column 8, line 59-Column 9, line 61, wherein the prepolymer is n-vinylpyrrolidone/vinyl acetate, which is a hydrophilic compound with pendant hydroxyl and unsaturated vinyl groups and wherein the prepolymer includes 5-20% of either methacrylamide, hydroxyethyl acrylate, which are hydrophilic compounds with pendant hydroxyl and unsaturated vinyl groups).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lally et al in view of Su et al.

Regarding claims 4 and 9, Lally et al discloses a method of making a reactive tinting compound as shown above, but does not specifically disclose that the second compound is

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substituted fluouro-chloropyrimidine Reactive Blue 114. Su et al teaches of a method of making a tinted contact lens (Abstract) wherein the dye used is Reactive blue 114 (See Table, Column 7) for the purpose of providing a reactive dye of any desired shade or tint with the necessary exoskeleton bond (Column 5, line 19-Column 6, line 40). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the method of making a reactive tinting compound as disclosed above further include the second compound made of substituted fluouro-chloropyrimidine Reactive Blue 114 since Su et al teaches of a method of making a tinted contact lens wherein the dye used is Reactive blue 114 for the purpose of providing a reactive dye of any desired shade or tint with the necessary exoskeleton bond.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lally et al.

Regarding claim 22, Lally et al discloses a method of making a reactive tinting compound as disclosed above wherein the dye is activated with a base compound, but does not specifically disclose that the base compound is an alkaline metal hydroxide, ammonia, or a salt of an alkaline. However Lally et al teaches of a using sodium hydroxide as a base compound, which is combined with the second compound for the purpose of lowering the pH of the polymer precursor (Column 20, lines 28-53). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the base compound added to the first compound be an alkaline metal hydroxide since Lally et al teaches of a using sodium hydroxide as a base compound which is combined with the second compound for the purpose of lowering the pH of the polymer precursor.

Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lally et al in view of Bawa.

Regarding claims 12 and 24, Lally et al discloses a method of making a reactive tinting compound as disclosed above, but does not specifically disclose that the polymerization inhibitor is hydroquinone. Bawa teaches of a tinted contact lens (Abstract) wherein hydroquinone is used as a polymerization inhibitor for the purpose of avoiding rapid curing or polymerization of the monomer (Column 3, lines 39-48). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the method of making a reactive tinting compound of Lally et al to further include hydroquinone as the polymerization inhibitor since Bawa teaches of a tinted contact lens wherein hydroquinone is used as a polymerization inhibitor for the purpose of avoiding rapid curing or polymerization of the monomer.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lally et al in view of Baba et al.

Regarding claim 32, Lally et al discloses a tinted contact lens as disclosed above, but does not specifically disclose that the acrylic cross linker is ethylene glycol dimethacrylate as the cross linker. Baba et al teaches of a contact lens wherein ethylene glycol dimethacrylate is used as the cross linking agent for the purpose of obtaining a highly safer ocular lens material with excellent mechanical strength (Column 12, line 65-Column 13, line 9). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the tinted contact lens of Lally et al to further include ethylene glycol dimethacrylate as the cross linker since Baba et al teaches of a contact lens wherein ethylene glycol dimethacrylate is used as the cross linking agent for the purpose of obtaining a highly safer ocular lens material with excellent mechanical strength.

Response to Arguments

Applicant's arguments filed November 20, 2004 have been fully considered but they are not persuasive. Specifically, applicant argues that the first compound does not comprise primarily of a hydrophilic compound with pendant hydroxyl and unsaturated vinyl groups. However, while the examiner agrees that Lally et al discloses that certain hydrophilic compounds, such as methacrylamide and hydroxyethyl acrylate, can be added "up to 20 percent", Lally et al also discloses that other hydrophilic compounds, such as n-vinylpyrrolidone/vinyl acetate, can make up the polymer precursor without being limited to "up to 20 percent", thereby disclosing the first compound comprising "primarily" a hydrophilic compound (Column 9, lines 28-35 and 57-61, wherein the polymer precursor is made of n-vinylpyrrolidone, which is a hydrophilic compound with pendant hydroxyl and unsaturated vinyl groups). Applicant argues that the starting material of Lally et al comprising a long chain of oligomers with a molecular weight greater than 2000, however, it is not claimed that the base material have a low molecular weight. In addition, applicant argues that the process of Lally et al includes more steps than the present invention, however, it is not claimed that the method of the invention only include the claimed steps. Applicant argues that the weight ratio of the compounds is 2-5% rather than the molar ratio; however, the reaction of the prepolymer and the dye having a 1/1 molar ration is shown in Figure 3. Applicant also argues that the combination of Su et al teaches of using Reactive Blue to tint already formed contact lens, however Su et al is used to show that contact lenses can be dyed with Reactive blue at some point in the manufacturing process, whether or not the lens has already been formed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

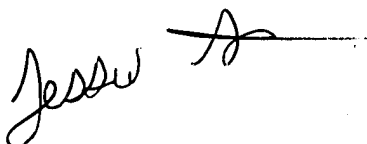
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica T Stultz whose telephone number is (571) 272-2339. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on 571-272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jessica Stultz
Patent Examiner
AU 2873
January 24, 2005

Handwritten signature of Jessica Stultz in black ink.Handwritten signature of Jordan Schwartz in black ink.

JORDAN SCHWARTZ
PRIMARY EXAMINER